

PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Michael Mantor, et al.

Examiner: unassigned

Serial No: 09/502,994

Art Unit: 2775

Filed: February 11, 2000

Docket: 11142

For: 3-D RENDERING TEXTURE CACHING  
SCHEME

Dated: November 1, 2000

**RECEIVED**

NOV 06 2000

Assistant Commissioner for Patents  
United States Patent and Trademark Office  
Washington, D.C. 20231

OFFICE OF PETITIONS

**STATEMENT OF FACTS IN SUPPORT OF FILING  
ON BEHALF OF NON-SIGNING INVENTORS**

Sir:

I, Paul J. Esatto, Jr., declare and state as follows:

1. The above referenced non-provisional application was filed on February 11, 2000. The application claims priority to a provisional application filed February 11, 1999.
2. All the inventors were employed by Real 3D, Inc. ("Real 3D") at the time the invention was made, and all had a obligation to assign the invention to Real 3D. The inventors reviewed the provisional application and provided the undersigned with changes.

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**CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on November 1, 2000.

Dated: November 1, 2000

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Mishelle Mustafa

Prior to February 11, 2000, the non-signing inventors, namely, Michael Mantor, John Austin Carey and Ralph Clayton Taylor, left the employ of Real 3D. The three non-signing inventors subsequently became employed by a competitor of Real 3D, namely, ATI Technologies, Inc. ("ATI"). The changes provided by the inventors were included in the non-provisional application.

3. Subsequent to the non-signing inventors becoming employed by ATI Technologies, Inc., Real 3D instituted a lawsuit against ATI alleging patent infringement and violation of trade secrets, among other causes of action.

4. On May 8, 2000 the undersigned received a Notice of Missing Parts dated May 1, 2000 from the United States Patent and Trademark Office.

5. Immediately thereafter, on May 12, 2000 the undersigned forwarded a letter to litigation counsel for Real 3D requesting that he forward the Declaration, Assignment and copy of the application to the inventors for signature. The code of ethics requires that where there is litigation between two companies direct contact by one attorney with an employee of one of the other parties is not permitted under certain circumstances. Such contact can only be made through counsel. Therefore, immediately thereafter, in a letter dated May 17, 2000, the litigation counsel representing Real 3D forwarded a copy of the application together with a Declaration and an Assignment to counsel representing ATI requesting that said counsel forward the application and Declaration and Assignment to the non-signing inventors for their signatures. A copy of the undersigned's letter of May 12, 2000 is attached as Exhibit A and a copy of the litigation counsel for Real 3D's letter to ATI is attached as Exhibit B.

6. The undersigned followed up with Real 3D's litigation counsel for a status during the following 30 days. Litigation counsel advised that counsel representing ATI had

indicated he was discussing the matter with in-house counsel for ATI but no decision had been reached. Thereafter, on or about June 26, 2000, I was informed by Real 3D's litigation counsel that counsel for ATI had indicated that it was necessary for his firm to withdraw as counsel representing ATI because of a conflict and, therefore, could no longer handle the matter. After discussing the matter with Real 3D's litigation counsel, it was decided that we would wait for new counsel to be engaged by ATI. However, after another 30 days past without new counsel being hired by ATI, it was decided that we would make direct contact with ATI in-house counsel.

7. The undersigned, on August 1, 2000, then contacted in-house counsel for ATI, Sally Daub, to request that she have the inventors execute the Declaration. Ms. Daub refused to request that the inventors sign the Declaration indicating that because she did not have litigation counsel yet, she did not want to look into the matter without such counsel. We chose to wait for ATI to select new counsel, believing it to be preferable to make all attempts to have the inventors sign the Declaration.

8. The undersigned regularly followed up with Real 3D's litigation counsel to determine when and if ATI had retained new counsel. Having been informed that ATI had finally engaged new counsel, the undersigned contacted new counsel for ATI on October 23, 2000 and said counsel requested that we forward a copy of the application and Declaration to him and he would review the matter. A copy of the October 23, 2000 letter is attached as Exhibit C. In a letter dated October 25, 2000, attached hereto as Exhibit D, the new counsel refused to submit the documents to the non-signing inventors for review indicating that the time was insufficient for them to review the papers. The letter attempts to assert that the documents should have been presented to this new counsel several weeks earlier. However,

ten days is sufficient time for the inventors to review the application and sign the Declaration, because as noted above, the application had been previously reviewed by them prior to the non-provisional application being filed while they were employed by Real 3D.

9. The undersigned and counsel for Real 3D made reasonable and diligent efforts to obtain the signatures of the non-signing inventors. The applications were forwarded to counsel representing the non-signing inventors new employer immediately upon receipt of the Notice to Filing Missing Parts. The employer of the non-signing inventors, ATI Technologies, Inc., took over three months to find new counsel and refused to submit the papers to the inventors or deal with this matter in any way during the entire six month statutory time period. Therefore, it is respectfully requested that the Petition Under 37 C.F.R. § 1.47(a) be granted.

10. The last known addresses of the non-signing inventors are:

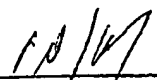
Michael Mantor  
4318 Saddle Creek Place  
Orlando, FL 32829

John Austin Carey  
840 Benchwood Court  
Winter Springs, FL 32708

Ralph Clayton Taylor  
1548 Rockwell Heights Drive  
Deland, FL 32724

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the

United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

  
\_\_\_\_\_  
Paul J. Esatto, Jr.  
Reg. No. 30,749

Scully, Scott, Murphy & Presser  
400 Garden City Plaza  
Garden City, New York 11530

PJE:ae

# **EXHIBIT A**

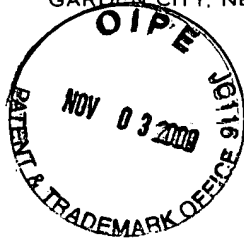
SCULLY, SCOTT, MURPHY & PRESSER

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ATTORNEYS AT LAW

400 GARDEN CITY PLAZA

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WILLIAM C. ROCH

PETER I. BERNSTEIN  
MARVIN BRESSLER  
STEPHEN CANNAVALE  
STEVEN FISCHMAN  
THOMAS SPINELLI  
PATRICIA A. WILCZYNSKI  
\*NJ BAR ONLY

LESLIE S. SZIVOS, PH.D.  
ALEXANDER G. VODOVOZOV, J.D.  
XIAOCHUN ZHU, PH.D.  
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ALLEN R. MORGANSTERN  
STEPHEN A. YOUNG  
COUNSEL

JOHN F. SCULLY (RETIRED)

ANTHONY C. SCOTT (1931-1994)  
WILLIAM E. McNULTY (1927-1993)

TELEPHONE: (516) 742-4343  
FACSIMILE: (516) 742-4366  
E-MAIL: intprop@ssmp.com

May 12, 2000

VIA FEDERAL EXPRESS

286 0905 747

Louis S. Mastriani, Esq.  
Adduci, Mastriani & Schaumberg, L.L.P.  
1200 Seventeenth Street, N.W.  
Fifth Floor  
Washington, DC 20036-3006

Re: 3D RENDERING TEXTURE CACHING SCHEME  
Michael Mantor, et al.  
Serial Number: 09/502,994  
Filed February 11, 2000  
Real 3D, Inc.  
Our Docket: 11142

Dear Lou:

The above referenced patent application was filed on February 11, 2000, claiming priority of a provisional application filed on February 11, 1999. The application incorporates several changes to the specification made by Michael Mantor before he left Real 3D.

In order to complete the filing requirements with reference to the above application, we are now required to file a Declaration and Power of Attorney. A copy of the Notice to File Missing Parts is enclosed. An Assignment should also be submitted for recordation at this time.

Enclosed is a copy the application, together with Declaration and Assignment forms. Three of the named inventors are Michael Mantor, John Austin Carey and Ralph Clayton Taylor who, according to our records, are all employed by ATI.

Please obtain the necessary signatures on the forms as soon as possible. We will obtain the signatures of the other

inventors, namely, Thomas Piazza, Jeffrey Potter and Angel Soccaras.

Please note that the Declaration must be filed by **July 1, 2000**, in view of the receipt of the enclosed Notice To File Missing Parts. The term can be extended up to four months with payment of extension fees, however, as you know, the fees become increasingly more expensive.

Please do not hesitate to contact us, if you have any questions or comments.

Very truly yours,

Paul J. Esatto, Jr.

PJE:ae  
Enclosures



## **EXHIBIT B**

ADDUCI, MASTRIANI & SCHAUMBERG, L.L.P.

ATTORNEYS AT LAW

V. JAMES ADDUCI II  
LOUIS S. MASTRIANI  
TOM M. SCHAUMBERG  
BARBARA A. MURPHY  
TIMOTHY SULLIVAN  
KATHERINE S. NUCCI  
HARVEY B. FOX  
GREGORY C. ANTHES  
STEVEN E. ADKINS  
MICHAEL L. DOANE  
ALLAN J. STEVENSON  
ALFRED M. HAAS  
ADAM F. BOBROW  
CARIDAD BERDUT\*  
MAUREEN F. BROWNE  
\*ADMITTED TO A BAR OTHER THAN D.C.

1200 SEVENTEENTH STREET, N.W.  
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www.adduci.com



OF COUNSEL

ROBERT A. WESTERLUND  
RAYMOND H.J. POWELL, JR.\*  
RAMON R. HOCH\*

DAVID A. GUTH  
(1953-1997)

May 17, 2000

**VIA HAND DELIVERY**

Ruffin B. Cordell, Esq.  
Fish & Richardson, P.C.  
601 Thirteenth Street, N.W.  
Washington, D.C. 20005

Re: Real 3D, Inc. v. ATI Technologies, Inc., *et al.*  
C.A. No. 99-641-CIV-19B  
3D RENDERING TEXTURE CACHING SCHEME  
Michael Mantor, *et al.*  
Serial Number: 09/502,994  
Filed February 11, 2000  
Real 3D, Inc.

Dear Ruffin:

Per our conversation yesterday, enclosed are copies of the Declaration, Power of Attorney and Assignment forms for filing in the referenced patent prosecution. A copy of the patent application is also enclosed for the inventors' reference. Real 3D requires that the three named inventors presently employed by ATI, Michael Mantor, John Austin Carey and Ralph Clayton Taylor, sign the appropriate documents and return them to us for filing by Real 3D's patent counsel as soon as possible.

Please forward the enclosed forms to the three individuals named above to obtain the necessary signatures. The Declaration must be filed by **July 1, 2000**, in view of the receipt of the enclosed Notice to File Missing Parts.

Ruffin B. Cordell, Esq.  
May 17, 2000  
Page 2

In addition, note that the forwarded materials comprise and contain highly sensitive confidential information and may not be disclosed to any entities other than the named inventors and outside counsel of record.

Finally, on an unrelated matter, please advise me at your earliest convenience whether your firm prosecutes patent applications for ATI Technologies, Inc. or any other computer graphics companies.

Very truly yours,

Louis S. Mastriani

LSM:krl  
Enclosures  
RR303800-1

## **EXHIBIT C**

**SCULLY, SCOTT, MURPHY & PRESSER**

A PROFESSIONAL CORPORATION

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THOMAS SPINELLI  
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LESLIE S. SZIVOS, PH.D.  
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October 23, 2000

**VIA FEDERAL EXPRESS**

303 0137 731

Lindley J. Brenza, Esq.  
Bartlit Beck Herman Palenchar & Scott  
Courthouse Place 54  
West Hubbard Street  
Chicago, IL 60610

**RECEIVED**

**NOV 06 2000**

**OFFICE OF PETITIONS**

Re: Real 3D, Inc. v. ATI Technologies, Inc., et al.  
C.A. No. 99-641-CIV-19B  
3D RENDERING TEXTURE CACHING SCHEME  
Michael Mantor, et al.  
U.S. Patent Application 09/502,994  
Filed: February 11, 2000  
Real 3D, Inc.  
Our Docket 11142

Dear Mr. Brenza:

Per our conversation today, enclosed are copies of the Declaration, Power of Attorney and Assignment forms for filing in the referenced patent prosecution. A copy of the patent application is also enclosed for the inventors' reference. Real 3D requires that the three named inventors presently employed by ATI, Michael Mantor, John Austin Carey and Ralph Clayton Taylor, sign the appropriate documents and return them to us for filing by Real 3D's parent counsel as soon as possible. As I mentioned to you in our conversation, previous attempts to obtain the signatures through Sally Daub were unsuccessful.

Please forward the enclosed forms to the three individuals named above to obtain the necessary signatures. The Declaration must be filed by November 1, 2000 in view of the receipt of the enclosed Notice to File Missing Parts. This term cannot be extended.

In addition, please note that the forwarded materials comprise and contain highly sensitive confidential information and may not be disclosed to any entities other than the named inventors and outside counsel of record.

Further, this letter confirms your agreement with Alfred M. Haas, trial counsel to Real 3D, that neither Real 3D's submission of these materials to you for forwarding to the referenced inventors, nor any review that these inventors, ATI, or counsel may conduct of these documents constitutes a waiver of any applicable privileges or immunities associated with these documents. As discussed, Real 3D agrees that any information imparted to Real 3D's former employees solely by their review and execution of these documents at this time shall not be used to substantiate further Real 3D's trade secret claims.

We look forward to receipt of the signed documents before the due date of November 1, 2000.

Very truly yours,

Paul J. Esatto, Jr.

PJE:ae  
Enclosures

cc: Louis S. Mastriani, Esq.

## **EXHIBIT D**

# BARTLIT BECK HERMAN PALENCHAR & SCOTT

A LAW PARTNERSHIP INCLUDING PROFESSIONAL CORPORATIONS

www.bartlit-beck.com

2000 OCT 30 A 10:37

RECEIVED  
October 25, 2000

*Via Facsimile and First Class Mail*

Paul J. Esatto, Jr.  
Scully, Scott, Murphy & Presser, P.C.  
400 Garden City Plaza  
Garden City, NY 11530

Re: Assignment, Declaration and Power of Attorney

Dear Paul:

I received the materials you sent yesterday and your e-mail this morning requesting an immediate response to your request that certain ATI employees execute documents related to a Real3D patent application. This is my attempt to give you an immediate answer. I have reviewed the materials. Because of my preliminary conclusions, I have not forwarded them on to the employees you name. Given the time frame you appear to be working under, and the complexity of the issues involved, the documents you have forwarded will not be executed within the time frame you have outlined.

First, the letter you sent to me did not correctly describe the agreement I thought I had reached with Mr. Haas yesterday concerning the conditions on which we would provide these materials to ATI employees for review. Mr. Haas and I agreed that we would provide the R3D patent application materials to the ATI employees you have identified only on condition that R3D waive any reliance on this review to support any possible trade secret claims against ATI. Your letter, however, limits this waiver to further substantiation of R3D's current trade secret claims.

Second, given the complexity of the materials sent, it will require a reasonable amount of time to review them. The non-negotiable deadline you provided me when you raised this with me for the first time earlier this week does not provide us enough time to perform this review. I understand that you previously unsuccessfully attempted to obtain review of these materials during a period when ATI was deprived of its counsel because of Intel's involvement in this litigation. However, my firm appeared as counsel for ATI over five weeks ago. We do not think it is prudent to attempt to respond to your request under the pressure of the short deadline you have provided.

## CHICAGO OFFICE

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54 WEST HUBBARD STREET  
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TELEPHONE: (312) 494-4400  
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## DENVER OFFICE

1899 WYNKOOP STREET  
8TH FLOOR  
DENVER, CO 80202  
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FACSIMILE: (303) 592-3140

## WRITER'S DIRECT DIAL:

(312) 494-4434  
lindley.brenza@bartlit-beck.com

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**NOV 06 2000**

**OFFICE OF PETITIONS**





BARTLIT BECK HERMAN PALENCHAR & SCOTT

Paul J. Esatto, Jr.  
October 25, 2000  
Page 2

Finally, my initial review of the Assignment you have forwarded for signature suggests that it is much more than an assignment, and that it attempts to impose obligations on ATI employees to assist Real3D that are inappropriate given the fact that these two companies are in litigation with each other. For example, it requires the relevant ATI employees to "generally do everything possible which said Assignee, its successors, and assigns or representatives shall consider desirable for aiding in securing, maintaining and enforcing proper patent protection" for the material in the patent application. This provision would put a virtually limitless obligation on ATI's employees to help Real3D. As I read it, it would even require ATI employees to act as expert witnesses for Real3D against ATI in either Real3D's current trade secret case or in a subsequent patent infringement case involving the material in the patent application. We cannot agree to the imposition of this kind of conflicting obligation on our employees, nor do we think it necessary or appropriate for R3D to seek it.

In short, for these reasons and potentially others that time did not permit me to identify, we cannot forward the documents you have drafted to our employees for signature within the time frame you have allowed.

Very truly yours,

A handwritten signature in black ink, appearing to read "L. J. Brenza", with a long horizontal flourish extending to the right.

Lindley J. Brenza

LJB/dlh